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WORLD.COM, INC.
TECHNOLOGY LAW DEPARTMENT
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JUL 26 2004

OFFICE OF PETITIONS

In re Application of :
Barry, et al. : DECISION ON PETITION
Application No. 09/159,695 :
Filed: September 24, 1998 :
Atty. Dkt.: COS-97-087 :

This decision is in response to the "RENEWED PETITIONS UNDER 37 CFR 1.48(a) AND 37 CFR 1.47(a)," filed June 8, 2004.

The above-identified application was filed September 24, 1998. An executed declaration naming B. Barry, M. Chodoronek, E. Deroose, M. Gonzales, A. James, L. Levy, and M. Tusa as joint inventors. Petitioner herein seeks to correct the inventive entity of this application to add inventor C. Devine as a joint inventor. A petition under 37 CFR 1.47(a) was filed December 12, 2003 and dismissed April 7, 2004.

DECISION UNDER 37 CFR 1.47(a)

The petition under 37 CFR 1.47(a) is hereby **DISMISSED**.

The first executed oath or declaration filed establishes the inventive entity of an application. The provisions of 37 CFR 1.47 are only applicable to original oaths or declarations. The provisions of 37 CFR 1.47 may not be utilized for the purposes of correcting an error in inventorship made without deceptive intent. See, 37 CFR 1.41(a)(1), 37 CFR 48(f)(1), and MPEP 201.03.

Wherein an original executed oath or declaration has been submitted and it is later determined that the original executed oath or declaration failed to set forth the correct inventive entity and this error in inventorship was made without deceptive intent, a petition under 37 CFR 1.48 may be filed. A petition under 37 CFR 1.47 filed in conjunction with a petition under 37 CFR 1.48 would be appropriate wherein an inventor that was not named in the original executed oath or declaration refuses to

execute the amended oath or declaration in accordance with 37 CFR 1.63.

For example and as set forth at MPEP 201.03, a petition under 37 CFR 1.47 would be appropriate where A, B, and C were originally named as inventors and D who refuses to cooperate is to be later added as an inventor. Only the oath or declaration under 37 CFR 1.63 of inventor D may be supplied pursuant to 37 CFR 1.47(a).

The provisions of 37 CFR 1.47 cannot be utilized for the purposes of correcting an error in inventorship in an original executed oath or declaration wherein an inventor that executed the original oath or declaration thereafter refuses to sign or cannot be located to sign the amended oath or declaration (e.g., inventors A, B, and C in the example set forth above). See, MPEP 201.03(B) for further guidance.

A fully executed declaration exists in the instant application. Thus a petition under 37 CFR 1.47(a) is inappropriate and without merit because the inventor sought to be added, i.e., C. Devine, has executed the declaration in compliance with 37 CFR 1.63 and 1.64.

DECISION UNDER 37 CFR 1.48

The petition under 37 CFR 1.48 is hereby DISMISSED.

Correction of inventorship pursuant to 37 CFR 1.48(a) requires the following: (1) a request to correct the inventorship that sets forth the desired inventorship change; (2) a statement from each person being added as an inventor and from each person being deleted as an inventor that the error in inventorship occurred without deceptive intention on his or her part; (3) an oath or declaration by the actual inventor or inventors as required by 37 CFR 1.63 or as permitted by 37 CFR §§ 1.42, 1.43 or 1.47; (4) the processing fee set forth in 37 CFR 1.17(I); and (5) if an assignment has been executed by any of the original inventors, the written consent of the assignee.

The petition lacks the required oath or declaration executed by each of the actual inventors as required under 37 CFR 1.63. As previously indicated, petitioner cannot avail himself to the provisions of 37 CFR 1.47 to permit the application to be prosecuted without a declaration signed by each of the inventor named in the application as a properly executed declaration was previously submitted November 30, 1998.

Petitioner seeks to correct the inventorship of the instant application pursuant to 37 CFR 1.48. Petitioner alleges inability to procure the signatures on of inventors E. Derosé, M Gonzales, and L. Levy on the required declaration. Without a fully executed oath or declaration in compliance with 37 CFR 1.63, petitioner cannot prevail under 37 CFR 1.48.

ALTERNATE REMEDY

If deemed appropriate and as stated in the decision on petition mailed April 7, 2004, to correct the inventorship in the instant application, petitioner should consider doing as follows:

- (1) re-submitting the petition under 37 CFR 1.48; and
- (2) submitting a petition under 37 CFR 1.183 (and required petition fee) requesting waiver of the requirements of 37 CFR 1.48(a)(3). A petition under 37 CFR 1.183 must be accompanied by the required petition fee and an oath or declaration complying with 37 CFR 1.63 executed by the available inventors¹. The available inventor(s) should execute the oath or declaration. A petition under 37 CFR 1.183 should include sufficient evidence that the non-signing inventors are indeed unavailable after diligent efforts to locate them and present the declaration, or, after having sufficient time and access to the application papers (specification, including claims, drawings, and oath or declaration), the request under Rule 48 made to the inventors failed. See, MPEP 201.03(b) and MPEP 201.03(c).

Petitioner is given **TWO (2) MONTHS** from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Renewed Petition," and should only address the deficiencies noted herein. Failure to respond will result in abandonment of the application. Any extensions of time will be governed by 37 CFR 1.136(a).

Further correspondence with respect to this matter should be addressed as follows:

By mail:

Mail Stop Petition
Commissioner for Patents


¹ Petitioner is advised to submit a new oath or declaration executed by the available inventors. Non-initialed and/or non-dated alterations have been made to the oath or declaration submitted December 12, 2003. See, 37 CFR 1.52(c).

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By facsimile: (703) 872-9306

By delivery service: U.S. Patent and Trademark Office
(FedEx, UPS, DHL, etc.) 220 20th Street S.
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Telephone inquiries regarding this decision should be directed to the undersigned at (703) 305-0310.


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